

claims are replete with examples of claims that incorporate subject matter from non-elected species. Furthermore, many of *the claims improperly combine mutually exclusive species.*" (Emphasis added).

Clearly, if a single claim can read on allegedly mutually exclusive species, it is not the claim (or the election of it) that is improper, but *the restriction requirement that is improper.* Indeed, MPEP 806.04(e) states that "a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated *a generic or genus claim*)." As generic or genus claims, these claims must be examined and should be included in the election.

Furthermore, MPEP 806.04(f) states:

"Claims to be restricted to different species **must be mutually exclusive.** The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species." (Emphasis added).

For these reasons, Applicant requests withdrawal of the improper Restriction/Election requirement and examination of all of the claims.

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***Applicant's Remarks Regarding the "Notice of Non-Responsive Reply"***

In Applicant's initial response to the election requirement filed December 15, 2003, the Applicant took the Examiner at her word that "Applicant is expected to select one species and then *one subspecies from each of the subspecies groups* listed under the selected subspecies" and "Applicant is required...to elect a single disclosed species for prosecution (along with *one from each group of subspecies* associated with the elected species)" in electing Species I, Subspecies A<sub>3</sub> from the A group, B<sub>1</sub> from the B group, and C<sub>1</sub> from the C group, with traverse, for prosecution on the merits. However, the Applicant also alternately elected the invention of Species I, Subspecies A<sub>3</sub> with traverse to satisfy the normal election requirement of a single species.

As repeated herein, above, Applicant's initial response to the election requirement filed December 15, 2003 additionally noted that the alleged species/subspecies of the

election/restriction requirement had little to do with the claimed invention and, when they did relate to the claimed invention, mostly fell within the generic independent claims.

In the examples cited by the Examiner to allege the Non-Responsive Reply, the Examiner refers to Markush claims 32 and 59 when stating that the claims (and apparently the election thereof) were improper. Applicant respectfully submits, as stated above, that the restriction of the Markush claims is improper under MPEP 803.02. Additionally, even *if* the restriction was proper, Applicant is not required to amend any claims. As stated in MPEP 803.02:

“This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are *so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s)*. In applications containing claims of that nature, the examiner may require **a provisional election of a single species** prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, **the Markush-type claim will be examined fully with respect to the elected species** and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.” (Emphasis added).

Although the Examiner has stated that “Applicant is expected to amend the claims accordingly so that they are limited to the elected species and subspecies,” it is the Applicant’s position that no amendment is necessary. Where the scope of a claim embraces multiple species, it is generic and therefore must be examined. Where the claims are Markush claims, the restriction is improper under MPEP 803.02 and, even if proper, should be provisionally examined with respect to the elected species *without any requirement for the Applicant to amend claims*.

With respect to the Examiner’s allegations regarding claims 107 and 207, the Examiner is mistaken when alleging that claim 207 falls within Species II. As in claim 107, the information is delivered to users in claim 207 based upon their individual profile, based solely upon limitations in claim 107 from which it depends. Claim 207 further defines how the user profiles are initially defined, refined based on user responses, and analyzed to characterize how fast and in what directions a user profile is changing. It has nothing to do with delivering information to groups, as shown in the reproduced claim, below:

“207 The method of delivering personalized information to users of claim 107, wherein:

user profiles are initially formed by selecting a set of N topical fields of interest and defining a significance magnitude for each topical field to create an N-dimensional information space;

user profiles are refined by analyzing user responses to update the significance magnitude for each topical field;

a trajectory in said information space is interpolated based on the updated significance magnitudes; and

an information vector is defined as a vector tangent to said trajectory with a magnitude defined as the derivative of the trajectory function at a given point to characterize how fast and in what directions a user profile is changing.”

As none of the alleged reasons for the Examiner’s Notice of Non-Responsive Reply have any merit, Applicant submits that the prior reply was responsive, as is the present reply, and respectfully requests examination of the claims on the merits.

Indeed, as both this filing and the prior election include an identification of the species that is elected and a listing of all claims readable thereon, the filings are responsive.

#### ***Applicant’s Remarks Regarding the Examiner’s Arguments (Pages 3-5)***

In section 2 of the Office Action, beginning on page 3, the Examiner addresses the arguments filed by the Applicant regarding the propriety of the restriction requirement (the Applicant’s Traversal). In stating that the alleged restriction had little to do with the claimed invention, Applicant was addressing the issue that many claims were generic and that many species read on no claims.

Applicant is fully aware of MPEP 806.04(e), which states that claims are definitions of inventions and that *claims are never species*. Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*). *Species are always the specifically different embodiments*. Species are *usually* but not always independent as disclosed since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any commonality of operation, function or effect.

In the present case, the Markush groups explicitly disclose relationships and commonality of operation, function or effect. For example, in claim 32, a user’s request for specific

information, a user-defined schedule, and a specific event chosen by a user are all related as being “a condition determinative of said periodic delivery of said personal information” and are thus not truly independent.

To clarify Applicant’s position, Species I and II are improper since they are not mutually exclusive. For example, page 13, lines 9-12 states: “Each member of said group can specify the portion of information materials delivered based on his individual user profile and the portion delivered in accordance with group profile. Moreover, the portions of information items delivered based on individual or group profiles can be specified by a third party.” Because portions of personalized information can be delivered based on user profile, while other portions can be delivered based upon group profile, either of which can be specified by a third party, it is clear that the alleged Species can be used together and are therefore not mutually exclusive.

If, despite this clear evidence, the Examiner maintains that Species I, related to delivering information based on user profiles, is patentably distinct and non-obvious with respect to Species II, related to delivering information based on a group profile, then Applicant will not traverse the Restriction/Election in the next Office Action with respect to Species I and Species II, and will consider electing Species I, claims 1-103, 107-209, 213-317, 429-459, and 461-505. As all the claims above claim 429 related to group profiles with the exception of claim 460 are in Markush form, the user profile portion of those claims must still be examined. Additionally, please note that apparatus claim 429 is generic with respect to the two Species.

However, Applicant vehemently traverses the Election/Restriction requirements related to the Subspecies. Although just as arbitrary and improper as the Species, above, the Subspecies requirements are further improper for the reasons stated below:

- Species I - Subspecies A<sub>1.4</sub> are not mutually exclusive. Although page 10, lines 21-22 state that one delivery option should be selected, it does not imply mutual exclusivity - it is merely necessary that at least one delivery option be selected for the system to work. Page 10, line 22 to page 11, line 13 discuss the other options and makes clear that a user can request a “yet undelivered” issue from the publisher, which issue would only exist based upon another delivery method. As such, it is clear that the delivery methods are not mutually exclusive.
- Species I - Subspecies A<sub>1.3</sub> are claimed in an unrestrictable Markush group (see MPEP 803.02) in claims 32, 144, 246, 354, and 463.

- Species I - Subspecies B<sub>1,3</sub> are not mutually exclusive since analyzing a user profile for one purpose does not foreclose analyzing it for another purpose.
- Species I - Subspecies B<sub>1,2</sub> are claimed in an unrestrictable Markush group (see MPEP 803.02) in claims 59, 171, 273, 381, and 475.
- Species I - Subspecies B<sub>3</sub>, as described by the Examiner, is not disclosed or claimed, making any type of election impossible. Psychological testing can be done to determine profiles, but profiles are not analyzed for psychological testing.
- Species I - Subspecies C<sub>1,2</sub> are not mutually exclusive. The definition of a significance level as per Subspecies C<sub>1</sub> is part of claims 101, 207, 315, 423, and 504. These claims further include interpolating a trajectory in information space which is disclosed in the specification as using the unclaimed statistical evaluation of Subspecies C<sub>2</sub>.
- Species II - Subspecies A<sub>1,2</sub> are not mutually exclusive. Just because group interests can be mapped to a point in information space (Subspecies A<sub>1</sub>) does not mean that the direction the group profile is changing (Subspecies A<sub>2</sub>) cannot also be characterized.
- Species II - Subspecies A<sub>1,2</sub> do not read on any claims, making any type of election impossible.

For the reasons stated above, Applicant submits that the Election/Restriction requirement is improper and that all claims should be examined.

Respectfully submitted,



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